

REMARKS

In the Office Action, the United States Patent and Trademark Office has alleged that the application contains claims directed to the following distinct species of the claimed invention, viz., ring systems A, B, C and radicals D, E, F, G, H, I, J, K, L, M, X, R₁, R₂, R₃, R₁₄, R₁₅ and m. The Office Action further has required Applicants to elect a single disclosed species for prosecution on the merits and a listing of all claims readable thereon.

In order to be responsive to the Restriction Requirement, Applicants elect the species of Example 76, viz., 2-phenanthrenol,-1, 2, 3, 4, 4a, 9, 10, 10a-octahydron-4a-(phenylmethyl)—2-(1-propynyl)-7-(3-pyridinylmethoxy)-, [2R-(2 α ,4 α 10 α)]-, i.e., a compound of Formula I, wherein A is A-1, R₁₀ is -Z - O-(C₀-C₆)-alkyl-het, het is pyridyl, Z is C₀ i.e., Z is absent, R₉ is hydrogen, X is CH₂, R₁ is Z-aryl, aryl is phenyl, D is CR₇, R₁₆, R₇ and R₁₆ are both hydrogen, F is CR₄R₅, R₄ and R₅ are hydrogen, R₁₄ and R₁₅ are hydrogen, R₈ is hydrogen, m is 2, R₂ is OH and R₃ is C₂-C₁₀ alkynyl and there are no optional bonds in either ring B or ring C connecting ring atoms D, E and ring atoms E and the carbon ring atom on which R₂ and R₃ are substituted. Further, in response to the Restriction Requirement, it is respectfully submitted that the following claims read on the elected species: 1, 2, 3, 4, 5, 31, 32, 33, 34, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100, 101, 102 and 103.

Moreover, Applicants reserve the right to file a divisional application or divisional applications directed to the non-elected subject matter. However, pursuant to 37 C.F.R. §§1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when “two or more independent and distinct inventions are claimed in a single application.” (Emphasis added). Similarly, 37 C.F.R. §141(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application. However, the United States Patent and Trademark Office has not even shown in the alleged Restriction Requirement that the application contains several patentably distinct species. More specifically, the United States Patent and Trademark Office did not show that the various species alleged to be patentably distinct are independent. Moreover, the United States Patent and Trademark Office did not show that the various claimed species are patentably distinct. It just made mere conclusions that the species in the instant specification are patentably distinct without any rationale or reasoning. The United States Patent and Trademark Office has thus not met its burden.

Further the United States Patent and Trademark Office has not complied with the requirement of MPEP 808, which states

Every requirement to restrict has two aspects: (a) the reasons as distinguished from the mere statement of conclusion why the inventions as claimed are either independent or distinct and (b) the reasons for insisting upon restrictions there between....

The United States Patent and Trademark Office has not provided any rationale for imposing the Restriction Requirement; it merely concludes that the various species are patentably distinct. Without a proper basis, it is improper for the United States Patent and Trademark Office to impose a Restriction Requirement Applicants to elect a species. Therefore, in the absence of providing any rational for the Restriction Requirement why the inventions

claimed are independent and distinct, the Restriction Requirement is not in compliance with MPEP §808 and accordingly, should be withdrawn.

It is vital to all Applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to Applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that a restriction under 35 U.S.C. §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a Restriction Requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a Restriction Requirement with inadequate authority can lead to situations in which an Applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, Applicants respectfully urge the

Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the Applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The CCPA has observed:

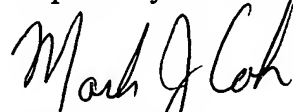
We believe that the constitutional purpose of the patent system is promoted by encouraging Applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 177 U.S.P.Q. 250, 256 (CCPA 1973).

Furthermore, Applicants respectfully request that in view of increased Official Fees and the potential limitations of Applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,



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